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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/929,242	RECEIVED CENTRAL FAX CENTER JUL 06 2006
	Filing Date	August 13, 2001	
	First Named Inventor	Stephen F. Gass	
	Art. Unit	3724	
	Examiner Name	Ghassem Ali	
Total Number of Pages in This Submission	8	Attorney Docket Number	SDT 306


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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	SD3, LLC		
Signature			
Printed name	David A. Fanning		
Date	July 6, 2006	Reg. No.	33,233

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JUL 06 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Date: July 6, 2006

STEPHEN F. GASS, DAVID A. FANNING, DAVID
S. D'ASCENZO, JOEL F. JENSEN, SUNG H. KIM
and ANDREW L. JOHNSTON

Serial No.: 09/929,242

Examiner Ghassem Alie

Filed: August 13, 2001

Group Art Unit 3724

For: RETRACTION SYSTEM FOR USE IN POWER EQUIPMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

1. Real party in interest.

The real party in interest is identified in the Appeal Brief.

2. Related appeals and interferences.

An update of the prior and pending appeals listed in the Appeal Brief follows:

1. Appeal of application serial number 09/929,227 (appeal brief and examiner's answer filed, reply brief due July 22, 2006).
2. Appeal of application serial number 09/929,238 (appeal brief and examiner's answer filed, reply brief due July 16, 2006).
3. Appeal of application serial number 10/053,390 (appeal brief and examiner's answer filed, reply brief due August 16, 2006).
4. Appeal of application serial number 10/100,211 (fully briefed).
5. Appeal of application serial number 10/189,027 (appeal brief filed, awaiting examiner's answer).

6. Appeal of application serial number 11/098,984 (appeal brief due August 30, 2006).

Applicant has also filed appeals in applications 09/929,221, 09/929,240, 09/929,425, 09/929,426, 10/189,031, 10/243,042 and 10/292,607, but those applications have either been allowed or prosecution has been reopened, so the appeals are no longer pending. Applicant identifies these prior appeals because the applications involved may be related to the present application.

3. Status of claims.

The statement of the status of the claims is in the Appeal Brief.

4. Status of amendments.

All amendments have been entered.

5. Summary of claimed subject matter.

The claimed subject matter is summarized in the Appeal Brief.

6. Grounds of rejection to be reviewed on appeal.

The grounds of rejection presented for review are set forth in the Appeal Brief.

7. Argument.

I. Claim 1.

The obviousness rejection of claim 1 should be reversed for any one of four independent reasons: 1) DE '771 teaches away from the claimed invention, 2) there is no reasonable expectation that the combination of DE'771 and Friemann would succeed, 3) there is no teaching, suggestion or motivation to make the combination, and 4) there are objective indicia of non-obviousness.

1. DE '771 teaches away.

The examiner did not deny or rebut the fact that DE '771 teaches away from a woodworking machine as recited in claim 1. In fact, the examiner did not even address this issue. DE '771 teaches away from the woodworking machine recited in claim 1 because if the saw disclosed in DE '771 were modified to detect contact instead of proximity, assuming it could be, then the resulting saw would be more dangerous. It would be more dangerous because a severe laceration or amputation could occur in the time required for the pneumatic or hydraulic cylinder disclosed in DE '771 to lower the blade after contact was detected. Because DE '771 teaches away, it does not support the obviousness rejection. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354, 60 USPQ2d 1001 (Fed. Cir. 2001); In re Haruna, 249 F.3d 1327, 1335-1336, 58 USPQ2d 1517 (Fed. Cir. 2001); In re Geisler, 116 F.3d 1465, 1469, 43 USPQ2d 1362 (Fed. Cir. 1997); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237 (CCPA 1969).

2. No reasonable expectation of success.

The examiner did not identify any prior art teaching that enables the combination of a contact detection system as disclosed in Friemann with a circular saw as disclosed in DE '771. Instead, he simply concluded that "these two detection systems were art-recognized equivalents at the time the invention was made," and therefore, it would have been obvious "to provide DE '771 with the detecting system in Friemann." (Examiner's Answer, 5-6.) The examiner said the two detection systems were equivalents because "some users prefer the rotation of the circular blade to be stopped when there is a contact between a person and the circular blade" and Friemann discloses a contact detection system. (Examiner's Answer, 5.)

The examiner's conclusion, however, is contradicted by the fact that not even one prior art reference shows a contact detection system used in a circular saw. In fact, structural and operational differences between circular saws and band cutters preclude the use of Friemann's detection system in circular saws, as explained in applicant's Appeal Brief on pages 9 and 10.¹ Because of these differences, there must be some teaching that enables the combination. Without such a teaching, the obviousness rejection cannot stand. In re Payne, 606 F.2d 303, 314, 203 USPQ 245, 255 (CCPA 1979); In re Kumar, 418 F.3d 1361, 1369, 76 USPQ2d 1048 (Fed. Cir. 2005); Motorola,

¹ One of the issues that would have to be addressed to modify a circular saw to include a contact detection system as disclosed in Friemann would be how to electrically isolate the circular blade. The examiner says "it would have been obvious ... to isolate the circular saw in DE '771 from the electric ground in many different ways that include a non-conducting member being positioned between the blade and the electric ground." (Examiner's Answer, 6.) The examiner did not cite any reference in support of that statement, but even if the examiner were correct, the examiner still did not address other issues such as how to connect the circular blade to the detection system or how to accommodate the changing position of a circular blade.

Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 1471, 43 USPQ2d 1481 (Fed. Cir. 1997); Beckman Instruments, Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989).

3. No teaching, suggestion or motivation.

The examiner says the suggestion to modify a circular saw as disclosed in DE '771 to include a contact detection system as disclosed in Friemann comes from the desire to prevent injury while allowing a person to work closely to the blade. (Examiner's Answer, 6-7.) There is no support for that conclusion. First, the combination would not "prevent injury;" it would require an injury because the modified saw would detect contact instead of proximity; and second, the examiner has not cited any reference saying there is a need to be able to work more closely to a circular saw blade.

The examiner is really saying that the woodworking machine of claim 1 is obvious because it is better – it allows a person greater work flexibility. But the fact that the woodworking machine of claim 1 is better supports a conclusion of patentability, not obviousness. The desire to make something better (i.e., by allowing greater work flexibility) cannot by itself constitute sufficient motivation to combine references because then all combinations would be suggested and no combinations would be patentable given that there is always a desire for better products.

4. Objective indicia of non-obviousness.

The examiner did not deny or rebut the fact that there has been a long felt but unsatisfied need for safer woodworking machines, as demonstrated by the continuing high number of injuries and the failure of systems as disclosed in DE '771 and Friemann

to address those injuries. This long felt but unsatisfied need supports a conclusion of non-obviousness.

II. Claim 5.

The examiner did not deny or rebut applicant's arguments that the Terauchi patent is non-analogous and that there is no suggestion to combine Terauchi with the other references. Therefore, the examiner's rejection of claim 5 should be reversed.

8. Claims appendix.

The claims are set forth in the Appeal Brief.

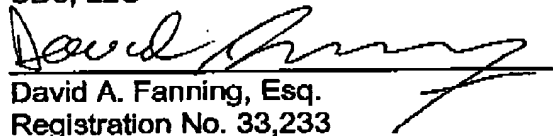
9. Evidence appendix.

None.

10. Related proceedings appendix.

None.


Respectfully submitted,
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Date: July 6, 2006

David A. Fanning